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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 10/773,916 | 02/06/2004 | Gjalt W. Huisman | MBX 017 CON (2) | 8457 |
| 23579 | 7590 | 03/14/2005 | EXAMINER | |
| PATREA L. PABST PABST PATENT GROUP LLP 400 COLONY SQUARE SUITE 1200 ATLANTA, GA 30361 | | | PATTERSON, CHARLES L JR | |
| | | ART UNIT | | PAPER NUMBER |
| | | | | 1652 |
| DATE MAILED: 03/14/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/773,916 | HUISMAN ET AL. | |
| | Examiner | Art Unit | |
| | Charles L. Patterson, Jr. | 1652 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 08 February 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

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The examiner has signed the IDS filed 2/8/04, which lists references supplied with the parent application. It is noted that none of the Foreign Patents listed in the parent application and on page 2 of the instant IDS have been included on the enclosed PTO-1449. If applicants wish them printed on the face of any patent that may issue from the instant application, they should submit another PTO-1449 listing these patents.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 and 1-13 of U.S. Patent No. 6,316,262 and 6,689,589, respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant patents are drawn to incorporating the same enzymes as in the instant claims into a host and/or vector, whereas the instant claims are drawn to incorporating the enzymes into a host that is stated to be a "plant, plant cell, or plant component". There is no limitation upon what the host cell is in the instant patents and therefore the patented claims incorporate the claims of the instant application. Furthermore, it would have been obvious to one of ordinary skill in the art to use any host, absent unexpected results.

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Claims 2, 5-7 and 12-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 6, 7, 12, 13 are indefinite in the recitation of "4HB-CoA transferase or "4HB". Abbreviations should be avoided in patent applications. The abbreviations should be defined in at least the first claim in which it appears. Changing the recitation in claim 2 to "4-hydroxybutyrate (4HB)-CoA transferase" would overcome this rejection.

Claim 5 is indefinite and confusing in the recitation of "PHA synthases". Apparently "synthases" should be "synthase" and abbreviations should be avoided in patent applications. The abbreviation should be defined in at least the first claim in which it appears. Changing the recitation "polyhydroxylalkanoate (PHA) synthase" would overcome this rejection.

Claims 14-17 are indefinite in the recitation of "The plant, plant cell, or plant component according to claim 1 [6, 12, 13]". Claims 1, 6, 12 and 13 are not drawn to a "plant, plant cell, or plant component" but rather to a recombinant host, a method, a 4HB polymer and a vector. Therefore there is no antecedent basis for the instant recitation in the claim from which they depend.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Patterson, Jr., PhD, whose telephone number is 571-272-0936. The examiner can normally be reached on Monday - Friday from 7:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached on 571-272-

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0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles L. Patterson, Jr.
Primary Examiner
Art Unit 1652

Patterson
March 9, 2005